



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/553,580

06/05/2006

Michinobu Tanioka

19246

1492

23389 7590 07/26/2007

SCULLY SCOTT MURPHY & PRESSER, PC

400 GARDEN CITY PLAZA

SUITE 300

GARDEN CITY, NY 11530

EXAMINER

VELEZ, ROBERTO

ART UNIT

PAPER NUMBER

2829

MAIL DATE

DELIVERY MODE

07/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,580

Applicant(s)

TANIOKA ET AL.

Examiner

Roberto Velez

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 11-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/17/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 1-20 are objected to because of the following informalities: Claim 1, Line 7 should recite, " provided to tips" instead of reciting "provided to the tips". Claim 10, Line 1 in page 4 should recite, "a inspection substrate" instead of "the inspection substrate". Appropriate correction is required.

Claims 2-9 and 11-20 depending from claim 1 are objected for the same reason.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 4-10 are rejected under 35 U.S.C. 102(e) as being anticipated by ***Esashi et al. (US Pat. 6,747,465)***.

Regarding claim 1, ***Esashi et al.*** shows (Figures 1-12) an inspection probe for inspecting electrical properties of a semiconductor device, comprising: a base member [11]; wiring layers [12] mounted on the base member [11]; probe pins [15], electrically connected to the wiring layers [12], protruding from the base member [11]; first metal layers [14] provided to tips [13E] of the probe pins [15]; and second metal layers [13C] formed on the wiring layers [12], wherein the first metal layers [14] and the second metal layers [13C] are separated from each other.

Regarding claim 2, ***Esashi et al.*** discloses everything as claimed above in claim 1; in addition, ***Esashi et al.*** discloses wherein the first metal layers [14] are made of a material having good contact properties selected depending on a material of external terminal electrodes [P] of the semiconductor device [W] (Col. 10, Ln 9-32).

Regarding claim 4, ***Esashi et al.*** discloses everything as claimed above in claim 1; in addition, ***Esashi et al.*** shows (Fig. 1) wherein the base member [11] has a plurality of the probe pins [15].

Regarding claim 5, **Esashi et al.** discloses everything as claimed above in claim 1; in addition, **Esashi et al.** discloses wherein the first metal layers [14] and the second metal layers [13C] are made of the homogeneous material (titanium as disclosed in Col. 5, Ln 23-32).

Regarding claim 6, **Esashi et al.** discloses everything as claimed above in claim 1; in addition, **Esashi et al.** discloses wherein the first metal layers [14] and the second metal layers [13C] are made of the heterogeneous material (gold and titanium as disclosed in Col. 5, Ln 23-32).

Regarding claim 7, **Esashi et al.** discloses everything as claimed above in claim 1; in addition, **Esashi et al.** discloses wherein the first metal layers [14] have hardness higher than that of the external terminal electrodes [P] of the semiconductor device [W] (Col. 5, Ln 28-32).

Regarding claim 8, **Esashi et al.** discloses everything as claimed above in claim 1; in addition, **Esashi et al.** shows (Fig. 6A) wherein a region [13E] for forming each first metal layer [14] has a width wider than or equal to half of the width of the probe pins [15] and a length longer than or equal to the sum of 1.0 time the size of the electrodes [P], **the distance that the inspection probe is moved after the inspection probe coming in contact with the electrodes, the longitudinal positional tolerance of the probe pins, and the length determined based on the positional tolerance of the electrodes.*

**This claim language is not given weight because claim 8 is claiming an apparatus, not a process of using the apparatus.*

Regarding claim 9, *Esashi et al.* discloses everything as claimed above in claim 1; in addition, *Esashi et al.* shows (Fig. 3) wherein the probe pins [15] form an angle of 0 to 45 degrees with respect to a face on which the electrodes [P] of the semiconductor device [W] are formed.

Regarding claim 10, *Esashi et al.* discloses everything as claimed above in claim 1; in addition, *Esashi et al.* shows (Figures 1-2) a flexible, electrically connectable wiring substrate [16] placed between the base member [11] and a inspection substrate [21] and a backup plate [24], mounted on the inspection substrate [21], for mounting the base member [11] thereon if the electrodes [P] of the semiconductor device [W] are arranged at sides thereof, correspond to multiple pins [15], and must be connected to the inspection substrate [21] (Col. 6, Ln 28-39).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Esashi et al.* (US Pat. 6,747,465).

Regarding claim 3, *Esashi et al.* discloses everything as claimed above in claim 1.

Esashi et al. is silent about disclosing wherein the second metal layers have a volume resistivity less than that of the wiring layers.

It would have been obvious to have second metal layers with a volume resistivity less than that of the wiring layers for the purpose of controlling the amount of current or voltage being applied to the electrodes in order to avoid damaging the electrodes.

Allowable Subject Matter

7. Claims 11-20 would be allowable if rewritten to overcome the claim objection, set forth in this Office Action, and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, taken alone or in combination, fails to disclose or render obvious, an inspection probe comprising a support substrate which is integrated with peripheral portions of the base member with an adhesive member placed there between and which is made of the same material as a material of the base member, said support substrate being mounted on the inspection substrate, wherein the backup plate has a protrusive portion at a center area thereof such that the probe pins form a predetermined angle with respect to the electrodes of the semiconductor device, as further disclosed in claim 11.

Claims 12-20 depending from claim 11 are also objected for the same reason.

Art Unit: 2829

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Velez whose telephone number is 571-272-8597. The examiner can normally be reached on Monday-Friday 8:00am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Roberto Velez
Patent Examiner



VINH NGUYEN
PRIMARY EXAMINER

A-4.2829
07/23/07